

REMARKS

Claims 55, 57-59, 61, 62, 64, 65, and 67-79 are pending in the subject application. The above claims stand rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,360,419 to Chen et al. For the following reasons, applicants respectfully traverse this rejection.

Independent method Claim 55 recites a step of: "binding the superabsorbent particles in particulate form to the binder containing cellulose fiber." Applicants assert that this feature of the claimed method is not anticipated expressly or inherently by Chen et al. and furthermore that this step is not obvious in view of Chen et al.

Chen et al. does not expressly disclose a binding step as recited in Claim 55. Accordingly, the final rejection, asserts that a binding step is inherently included in the process of Chen et al. because in Chen et al. the same chemical agent (glycerin or glycols) as in the claimed invention is used and sprayed on the web fibers. For the following reasons, the position taken in the final rejection that the claimed binding step is inherently present in the method of Chen et al. is incorrect.

Under the law of inherency, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). As stated in *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (PTO Bd. Pat. Int. 1990).

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The final rejection does not establish a *prima facie* case of inherency of the subject matter of Claim 55 because the final rejection does not set forth a *prima facie* case that the recited binding step is inherent in the teaching of Chen et al. Page 4 of the final rejection sets forth the conclusion that the claimed binding step is inherently included in the process of Chen et al. because Chen et al. discloses chemical agents (i.e. "other materials") spread on web fibers that are the same as the binders recited in the rejected claims. If the "other materials" in Chen et al. were applied to the fibers in the absence of additional materials, then perhaps the Examiner's Action arguably sets forth a basis in fact or technical reasoning for the conclusion that the "other materials" of Chen et al. inherently result in binding of particles to fibers. Unfortunately, Chen et al. teaches that there are materials on the fibers in addition to the "other materials."

Chen et al. describes a fibrous web of cellulosic material that includes a first complex forming material and a second complex forming material. According to Chen et al., when wetted, the first and second complex forming materials form a complex resulting in the fibrous web having improved integrity. One of the objects of Chen et al., as described at Col. 2, line 4, is to provide a fibrous web that possesses a high degree of wet and dry structural integrity while maintaining its absorbency and suppleness in both the dry and wet state. Chen et al., at Col. 4, lines 19-32, lists polymeric materials suitable for the first complex forming material. In the next paragraph, at lines 33-46 of Col. 4, polymeric materials useful as a second complex forming material are described. Chen et al. beginning at Col. 4, line 52, describes the "other suitable materials" which the Examiner's Action equates with the binders of the present invention. The list of other suitable materials include polyvinyl alcohol, glycerin, sorbitol, polyethylene glycol, propylene glycol, and low molecular weight polyethylene oxide.

In accordance with Chen et al., in addition to these "other materials," the fibrous web also contains at least the first and second complexing material. At least some of the polymeric materials described as being useful as the first and second complex forming materials include hydrogen bonding functionality. It is unclear from Chen et al. what effect the two complex

forming materials have on any interaction between the fibers, particles, and "other materials." In view of the presence of these two complex forming materials, it is not reasonable to conclude that the claimed binding step necessarily flows from the teachings of Chen et al. when considered in their entirety. As noted above, the possibility that the claimed binding step may occur in Chen et al. is not sufficient to establish the inherency of the claimed binding step. For these reasons, binding of particles to fibers is not a step that is inherently disclosed in Chen et al. Accordingly, the subject matter of independent Claim 55, and the claims dependent therefrom, is novel over Chen et al.

The binding step of independent Claim 55 is not obvious in view of Chen et al., because Chen et al. does not suggest binding super absorbent particles to a nonpolymeric binder containing cellulose fiber. In fact, Chen et al., at Col. 10, lines 22-47, teaches away from the use of a binder to bind particles to fibers by teaching that particles can be entrapped or engaged within fibrous webs, that particles can be physically adhered to the fibrous webs when the complex forming material is a polymeric thermoplastic material, or particles can be adhered to the fibrous web using a tacky binder. Chen et al. does not suggest that particles can be bound to the cellulose fibers using the "other materials" (i.e. the compounds the Examiner's Action asserts are the same as the binder of the rejected claims) of Chen et al. Accordingly, the subject matter of independent Claim 55, and the claims dependent therefrom, is nonobvious over Chen et al.

Applicants assert that Claims 62, 65, 71-75, 78, and 79, which each depend from Claim 55, are novel and nonobvious for the reasons given above and also for the reasons given below.

Claim 62 recites that the binder is a nonpolymeric diol. Chen et al. does not disclose or suggest a binder that is a nonpolymeric diol as recited in Claim 62. The Examiner's Action asserts that the use of nonpolymeric diols as binders in a method for binding particles to fibers is taught by Chen et al. at Col. 4, lines 50-60 and Col. 1, lines 30-45. Col. 4, lines 50-60 of Chen et al. disclose the polymeric alcohol polyvinyl alcohol, and the polymeric glycols polyethylene

glycol and polypropylene glycol. These materials are not nonpolymeric diols. The same passage of Chen et al. also describes the triol glycerin and the hexol sorbitol. Again, these materials are not diols and do not anticipate or render obvious the nonpolymeric diols recited in Claim 62. Similarly, the passage at Col. 1, lines 30-45 does not disclose a nonpolymeric diol binder.

Dependent Claim 65 recites that the binder is propylene glycol. Chen et al. does not disclose propylene glycol which is a nonpolymeric diol, nor does it suggest using propylene glycol as a binder in a process that binds the particles to the fibers.

Claims 71-75 recite specific nonpolymeric glycols as binders. Chen et al. does not disclose or suggest the specific nonpolymeric glycols recited in Claims 71-75.

Claim 78 recites the binder is a hydroxy acid. Chen et al. does not disclose a method that employs a binder in the form of a hydroxy acid in order to bind particles to fibers. The Examiner's Action asserts that the use of hydroxy acid to bind particles to fibers is inherently disclosed by the description of alcohol, glycerin, and glycol at Col. 4, lines 50-60. Hydroxy acids include both hydroxyl functionalities and carboxyl functionalities. The disclosure of alcohol, glycerin, and glycol, which each include hydroxyl groups but do not include carboxyl groups, does not inherently anticipate hydroxy acids. Applicants are puzzled as to why the Examiner believes that the disclosure of an alcohol, glycerin, or a glycol inherently anticipate hydroxy acids. If the Examiner maintains this rejection, he is respectfully requested to expand on his reasoning for this inherency rejection.

Claim 79 recites that the hydroxy acid is lactic acid. Chen et al. does not disclose or suggest a method that uses lactic acid as a binder for binding particles to fibers. Lactic acid is a hydroxy acid so the arguments presented in the previous paragraph are equally applicable to Claim 79. The Examiner's Action asserts "that the selection or use of adjacent homologs or subsequent subspecies of the same class, i.e., hydroxy acid species, would have been obvious to a skilled artisan as merely using equivalent material (hydrogen bond and/or coordinate covalent bond) to achieve similar results." Applicants are unclear as to the meaning of this statement.

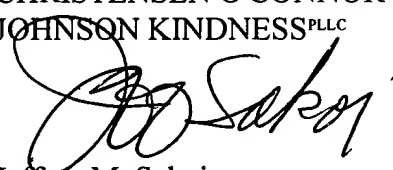
LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The Examiner's reasoning appears to be that since he has concluded that the subject matter of Claim 59 (nonpolymeric binder including hydroxyl functional groups) and Claim 78 (nonpolymeric binder is a hydroxy acid) is anticipated or obvious over Chen et al., the selection of a particular hydroxy acid subspecies, such as lactic acid, would be obvious. Applicants have pointed out how the subject matter of Claim 78, from which Claim 79 depends, is novel and nonobvious over Chen et al. The same arguments apply equally to dependent Claim 79, which depends directly from Claim 78.

For the foregoing reasons, the pending claims are novel and nonobvious over Chen et al. Accordingly, applicants respectfully request withdrawal of the outstanding rejection and allowance of the application. If the reviewing party has any questions regarding the above, he is invited to call applicants' attorney at the number listed below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}


Jeffrey M. Sakoi
Registration No. 32,059
Direct Dial No. 206.695.1713

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date:

12/20/04

Shanna L. H.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100